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PATENT  
Customer Number 22,852  
Attorney Docket No. 3063-0396-04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
John EBY et al. ) **PRIOR APPLICATION:**  
)  
Application No.: 09/749,033 ) Group Art Unit: 1732  
)  
Filed: December 28, 2000 ) Examiner: A. Kuhns  
)  
For: SURFACE COVERINGS HAVING )  
A NATURAL APPEARANCE AND )  
METHODS TO MAKE A )  
SURFACE COVERING HAVING )  
A NATURAL APPEARANCE )

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

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**INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)(4)**

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b)(4), Applicants bring to the attention of the Examiner the following information. This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits for the above-referenced application.

The above-captioned application claims benefit under 35 U.S.C. § 120 from the same family of applications that gave rise to U.S. Patent Nos. 5,961,903 and 6,114,008. In separate pleadings filed in on-going litigations, copies of which are enclosed herewith, third parties have asserted that the claims of U.S. Patent Nos. 5,961,903 and 6,114,008 are invalid or unenforceable for a number of reasons, including fraud and inequitable conduct. Consequently, those pleadings and

allegations may be material or relevant to the patentability of the instant claims, which have been allowed. While the Applicants consider the allegations to be frivolous and without merit, it is believed that Applicants are required to bring such material to the attention of the Patent Office. See M.P.E.P. 2001.6(c).

In addition to the attached pleadings, Applicants have submitted herewith documents related to Biscayne Decorative Products that were provided to the undersigned's firm on June 7, 2001, by a former employee of Biscayne Decorative Products. Biscayne Decorative Products allegedly manufactured and sold chemically and mechanically embossed products in the 1980's.

Applicants also submit an article appearing in the Floor Plant Journal in 1975, discussing Armstrong's "Tredway" product. Armstrong alleges in its pleadings that the "Tredway" product was mechanically and chemically embossed.

Applicants also submit U.S. Patents that were previously made of record in the pending parent application, U.S. Patent Application No. 09/287,631, filed April 7, 1999. These patents include those cited on the face of U.S. Patent No. 3,978,258 to Faust et al., which is already of record, U.S. Patent No. 5,441,563 to Sideman et al. and the article Andrew Hunter, "Inhibition of Chemically Foamed PVC Plastics - A Brief Study," *Cellular Polymers*, Vol. 2 (1983).

Finally, Applicants have identified several additional patents that have come to their attention as a result of discovery requests in a related arbitration proceeding and in preparation for the pending litigations. In an abundance of caution, these references are being submitted and are identified on the attached PTO-1449 form.

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Applicants respectfully request that the Examiner consider each document listed on the attached PTO-1449 form and indicate that consideration by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that the disclosed information is material or constitutes "prior art." If the Examiner applies the information as prior art against any claim in the present application and Applicants determine that the information does not constitute "prior art" under United States law, Applicants reserve the right to present to the Patent Office the relevant facts and law regarding the appropriate status of such information.

Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the disclosed information, should it be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 29, 2001

By: 

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